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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/028,997	12/20/2001	Gregory J. Wolff	015358-006800US	3773

20350 7590 04/17/2007		EXAMINER
TOWNSEND AND TOWNSEND AND CREW, LLP		ROSARIO, DENNIS
TWO EMBARCADERO CENTER		
EIGHTH FLOOR	ART UNIT	PAPER NUMBER
SAN FRANCISCO, CA 94111-3834	2624	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/17/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

	Application No.	Applicant(s)
	10/028,997	WOLFF ET AL.
Office Action Summary	Examiner	Art Unit	
	Dennis Rosario	2624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE **3** MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *RCE 3/5/07*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,3-27 and 29-77* is/are pending in the application.

 4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,3-27 and 29-77* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *20 December 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

 a)☐ All b)☐ Some * c)☐ None of:

 1.☐ Certified copies of the priority documents have been received.

 2.☐ Certified copies of the priority documents have been received in Application No. _____.

 3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

 * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
 Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
 Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1.   A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 3/5/07 has been entered.

Response to Amendment

2.   The amendment was received on 3/5/07. Claims 1,3-27 and 29-77 are pending.

Claim Objections

Claim 26 is objected to because of the following informalities:

Claim 26, line 8: "without selecting the button" has a multiple antecedent basis with respect to claim 25.

Appropriate correction is required.   -   -   .

Allowable Subject Matter

The indicated allowability of claim 24 is withdrawn in view of the newly discovered reference(s) to Yamazaki (US Patent 6,999,117 B2). Rejections based on the newly cited reference(s) follow.

Response to Arguments

3.   Applicant's arguments on page 23, filed 3/5/07 have been fully considered but they are not persuasive and states:

> **"...Shaffer fails to teach...'the first digital image designated as a template image using the image capture device'..."**

The examiner respectfully disagree since Shaffer discloses the first digital image (represented in fig. 6 as "First cut album pages") designated (via a "tem-plate ID" in col. 10, lines 30,31) as a template image using the image capture device (or a scanner represented in fig. 5 as "Submit album to be scanned and printed.") Note that the template was designated as a template image via the ID regardless of the claimed image capture device or the scanner and appears that some other process generates the ID that designates in general. Note that the applicant's image capture device does the designating as disclosed in the specification via a button on the claimed image capture device; however, claim 1 is not clear as to what is doing the active step of designating.).

Note that claim 1 would be better understood if claim 1, line 4 read as:

> **"**...designated as a template image **by (emphasis added)** using the image capture device **to designate the template image (emphasis added)** ...**"**

Accordingly, the newly proposed claim language claims that the claimed designated is or was designated by the image capture device.

4.   Applicant's arguments on page 23 have been fully considered but they are not persuasive and states:

"...Shaffer fails to teach...'constructing of one or more placement regions' ..."

The examiner respectfully disagrees since Shaffer discloses constructing of one or more placement regions (as represented in fig. 6 as "Change or delete photo or choose new template" which corresponds to "alter the placement of images" in col. 11, line 28 via an "arrow showing where the image is being moved on the photocollage [which corresponds to the claimed template image]" in col. 11, lines 30,31.) Thus, new placement regions are constructed on the template image by using an arrow that indicates an old position and a new position.

5.   Applicant's arguments on page 23 have been fully considered but they are not persuasive and states:

"...Shaffer fails to teach...'placing a digital image from the first set of digital images in the placement region' ..."

The examiner respectfully disagrees since Shaffer discloses placing a digital

image (see paragraph 4, above) from the first set of digital images (represented in fig. 9

as one of the six layout options that includes images represented in fig. 8) in the

placement region. Thus, an image such as layout option in the upper left corner with an

image from figure 8 is moved to a new placement region with the layout via said arrow

in the digital image embodiment of fig. 6.

6.   Applicant's arguments on page 24 have been fully considered but they are not

persuasive and states:

"...Shaffer fails to teach... 'constructing one or more placement regions

from the first digital image based upon features extracted from the first

digital image by applying an image analysis technique to the first digital

image, each placement region of the one or more placement regions

identifying a location on the first digital image for placing a digital image

from a first set of digital images captured using the image capture

device'..."

The examiner respectfully disagrees since Shaffer discloses constructing one or more placement regions from the first digital image (as discussed in paragraph 4, above) based upon features extracted from the first digital image by applying an image analysis technique to the first digital image (this limitation is broad enough that a "customer" in col. 10, line 61 via a "marking means" in col. 11, lines 28,29 can via a thought process of the customer to analyze/extract which images to place using said arrow and marking means to generate the arrow), each placement region of the one or more placement regions identifying a location on the first digital image for placing a digital image from a first set of digital images captured using the image capture device.

7.   Applicant's arguments on page 25 have been fully considered but they are not persuasive and states:

> **"This is substantially different from the 'constructing' feature of claim 1 where the image placement regions are actually constructed from features extracted from the image by an image analysis technique."**

The examiner respectfully disagrees for the same reasons as paragraph 6, above. In addition, another interpretation is presented in the context of "extracted" in col. 13, lines 9,10 and 12. Shaffer discloses image placement regions (corresponding to fig. 1,num. 17 that includes image placement regions known to one in the art of albums) that are actually constructed from features (or "digital data" in col. 13, line 11) extracted ("extracted" in col. 13, line 10) from the image by an image analysis technique (or "pattern recognition process" in col. 13, line 13).

8.   Applicant's arguments on page 25 have been fully considered but they are not persuasive and states:

"Shaffer fails to teach...'for each placement region of the one or more placement regions, placing a digital image from the first set of digital images identified for the placement region <u>in the placement region on the first digital image to generate the customized digital image'</u>..."

The examiner respectfully disagrees since Shaffer discloses for each placement region (as represented in fig. 9 as one of the 6 layout options) of the one or more placement regions, placing a digital image (any one image represented in fig. 8 as a "digital file" in col. 11, line 43) from the first set of digital images (as shown in fig. 8) . identified (via fig. 8,num. 119) for the placement region in the placement region on the first digital image to generate the customized digital image (represented in fig. 1 as num. 17).

9.   Applicant's arguments on pages 25 and 26 have been fully considered but they are not persuasive and states:

"...the customized digital image is generated by placing the image from the set of digital images into the first digital image itself... Applicants submit that this is not taught by Shaffer."

The examiner respectfully disagrees since Shaffer discloses that the customized digital image (as represented in fig. 1 as num. 15) is generated (via fig. 1,num. 13) by placing the image (see paragraph 5,above) from the set of digital images (represented in fig. 1 as num. 12) into the first digital image itself (as shown in fig. 6, label: "If new template, place proper picture into template", that corresponds to a digital embodiment meaning that all images are digital as opposed to an analog embodiment as shown in fig. 5 meaning that all the images are printed on film or stickers.

10.   In response to applicant's argument on page 26 that the references fail to show

certain features of applicant's invention, it is noted that the features upon which

applicant relies (i.e., composite image) are not recited in the rejected claim(s). Although

the claims are interpreted in light of the specification, limitations from the specification

are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057

(Fed. Cir. 1993).

11.   In response to applicant's argument on page 26 that the references fail to show

certain features of applicant's invention, it is noted that the features upon which

applicant relies (i.e., the image capture device can specify that an image is a template

image) are not recited in the rejected claim(s). Although the claims are interpreted in

light of the specification, limitations from the specification are not read into the claims.

See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

12.   Applicant's arguments on page 26, lines 18,19, with respect to "Schaffer provides

no teaching that an image captured by the scanner can be designated as a template

image by the scanner" have been fully considered and are persuasive. Note that this

statement corresponds to paragraph 3, above.

13.   Applicant's arguments see page 26, lines 23,24, with respect to "The scanner

does not 'designate' an image as a template image..." have been fully considered and

are persuasive. Note that this statement corresponds to paragraph 3, above. Shafer is

not clear as to what actually generates the designation mark as shown in fig. 9, num.

164 that designates or indicates num. 160 is a template image.

Applicant's arguments, see page 27, lines 7,8, with respect to "...Applicants have amended claim 25..." have been fully considered and are persuasive. However a new grounds of rejection has been made in view of Yamazaki (US Patent 6,999,117 B2).

14.   Applicant's arguments on page 27 have been fully considered but they are not persuasive and states:

"...Takahashi fails to teach... 'an image capture device having a selectable mode for capturing a template image'..."

The examiner respectfully disagrees since Takahashi discloses an image capture device (as shown in fig. 21, num. 101 and clearly shown in fig. 2, num. 101) having a selectable mode (as shown in fig. 21,num. 1802) for capturing a template image (as done in fig. 26, num. S103).

15.   Applicant's arguments on page 27 have been fully considered but they are not persuasive and states:

"...Takahashi fails to teach... 'constructing one or more placement regions from the first digital image'..."

The examiner respectfully disagrees since Takahashi discloses constructing (via a "enlarged or reduced" in col. 12, lines 25,26 operation) one or more placement regions (one of which is shown as the perimeter of fig. 16, label "IMAGE 2" that can "fit" in col. 12, line 26 an image when the image of fig. 15, label "IMAGE 2" in "enlarged or reduced" in col. 12, lines 25,26 so that IMAGE 2 is placed within the perimeter of the placement region) from the first digital image (fig. 15,num. 203).

16.   Applicant's arguments on page 27 have been fully considered but they are not persuasive and states:

"...Takahashi fails to teach... 'placing the second digital image in the first placement region on the first digital image'..."

The examiner respectfully disagrees since Takahashi discloses placing (see paragraph 15,above with respect to said "fit") the second digital image (as shown in fig. 15 as IMAGE 2) in the first placement region (as shown in fig. 16 as IMAGE 2) on the first digital image (figures 15 and 16, num. 203 is the same image but with placement regions such as IMAGE 1-5 adjusted).

17.   Applicant's arguments on page 28 have been fully considered but they are not persuasive and states:

"...Takahashi fails to teach...constructing one or more placement regions from the first digital image based upon features extracted from the first digital image by applying an image analysis technique to the first digital image"..."

The examiner respectfully disagree since Takahashi discloses constructing one or more placement regions from the first digital image (as discussed in paragraph 15, above) based upon features (such as fig. 15,num. 1401) extracted from the first digital image by applying an image analysis technique (as contemplated by a user via a user interface as shown in fig. 15, num. 1201) to the first digital image. Note that the claimed image analysis technique is broadly interpreted to include a person that analyzes, including a plurality of other actions that are capable by a user, an image and decides to alter the image. While the applicant's specification uses "analyzes the contents of the template image" in page 14, lines 18,19 and "analyzing the template image" on page 29, lines 21,22 of the REMARKS/ARGUEMENTS which is a distinction from Takahashi that teaches an image layout as shown in fig. 15 that is analyzed by a user that appears to be different from a template image as shown in figures 22 and 23.

18. Applicant's arguments on page 28 have been fully considered but they are not persuasive and states:

"...image placement regions are actually constructed from features extracted from the image by an image analysis technique. Applicants submit that such a concept is not taught by Takahashi."

The examiner respectfully disagrees since Takahashi discloses image placement regions (as shown in fig. 16 as IMAGE 1 and IMAGE 2) that are actually constructed (via a "enlarged or reduced" in col. 12, lines 25,26 operation) from features (such as the images of fig. 15, labels IMAGE 1 and IMAGE 2) extracted from the image by an image analysis technique (as discussed in paragraph 17, above).

19.   Applicant's arguments on page 28, lines 21,22 with respect to "Applicants submit that the recording sheet disclosed in Takahashi is not a template image." have been fully considered and are persuasive. However, the claimed template image is not associated with any active steps of claim 18.

20.   In response to applicant's argument on page 28,lines 24,25 that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e.,"... a template image comprising one or more 'placement regions'...") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

21.   Applicant's arguments on page 28 have been fully considered but they are not persuasive and states:

"...Takahashi is silent about applying an image analysis technique to extract features from the first digital image..."

The examiner respectfully disagrees since Takahashi is broadly interpreted to a apply an image analysis technique (as discussed in paragraphs 17 and 18, above) to extract (via fig. 15,num. 1201 that extracts one feature relative to other features) features (such as fig. 15,num. 1401 or IMAGE 2) from the first digital image.

22.   In response to applicant's argument on page 29, line 2 that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "...image processing technique...") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

23.   In response to applicant's argument on page 29, lines 4,5 that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "Placement regions for images on a template image...") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

24.   In response to applicant's argument on page 29, line 12 that the references fail to

show certain features of applicant's invention, it is noted that the features upon which

applicant relies (i.e., "...composite image...") are not recited in the rejected claim(s).

Although the claims are interpreted in light of the specification, limitations from the

specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26

USPQ2d 1057 (Fed. Cir. 1993).

25.   In response to applicant's argument on page 29, lines 14, 15 that the references

fail to show certain features of applicant's invention, it is noted that the features upon

which applicant relies (i.e., "...'constructing one or more placement regions' on a

template image...") are not recited in the rejected claim(s). Although the claims are

interpreted in light of the specification, limitations from the specification are not read into

the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

26.   Applicant's arguments on page 31 have been fully considered but they are not

persuasive and states:

     "...Simon fails to disclose...'constructing one or more placement regions

     from the template image'..."

     The examiner respectfully disagrees since Simon discloses constructing

one or more placement regions (as shown in fig. 7, num. 220) from the template image

(as shown in fig. 7,num. 200).

27.   Applicant's arguments on page 31 have been fully considered but they are not

persuasive and states:

>   **"...Simon fails to disclose...'placing the second digital image in the first**
>
>   **placement region on the template image'..."**

The examiner respectfully disagrees since Simon discloses placing the second

digital image in the first placement region on the template image (as indicated in fig.

5,num. 120).

28.   Applicant's arguments on page 31 have been fully considered but they are not

persuasive and states:

>   **"...Simon fails to teach at least the feature of 'constructing one or more**
>
>   **placement regions from the template image based upon features extracted**
>
>   **from the template image by applying an image analysis technique to the**
>
>   **template image, each placement region of the one or more placement**
>
>   **regions identifying a location on the template image for receiving a digital**
>
>   **image from the plurality of digital images captured by the image capture**
>
>   **device'..."**

The examiner respectfully disagrees since Simon discloses constructing one or more placement regions (as done in fig. 7,num. 270) from the template image (the output of fig. 7,num. 250 that represents a template image) based upon features (such as a bottom most image as determined in fig. 7,num. 270 of which a detail view is shown in fig. 16 wherein num. 310 determines said bottom most image) extracted (since the bottom most image was identified relative to other image that are not the bottom most image corresponds to the claimed extracted since the bottom most image was identified and separated from the other images for further processing) from the template image by applying an image analysis technique (fig. 16,num. 310 broadly reads as an image analysis technique) to the template image, each placement region of the one or more placement regions identifying a location on the template image for receiving a digital image from the plurality of digital images captured by the image capture device.

29.   Applicant's arguments on page 31 have been fully considered but they are not persuasive and states:

"...Simon is silent as to applying image analysis to a template image to determine placement regions within the template image."

The examiner respectfully disagrees since Simon applies image analysis to a template image (see paragraph 28, above) to determine placement regions (as done in fig. 16,numerals 350,410 and 420) within the template image.

30.   Applicant's arguments on page 32 have been fully considered but they are not persuasive and states:

"...Simon fails to teach...'placing a copy of a digital image from the plurality of digital images identified for the placement region <u>in the placement region on the template image to generate the customized digital image'...</u>"

The examiner respectfully disagrees since Simon discloses placing a copy (as done in fig. 7,num. 260 which outputs a scaled image) of a digital image (from fig. 5,num. 100) from the plurality of digital images identified (fig. 5,num. 120) for the placement region in the placement region on the template image to generate the customized digital image.

31.   In response to applicant's argument on page 32, line 13 that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "...transformed...") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

32.   Applicant's arguments on page 32ave been fully considered but they are not persuasive and states:

"The page layout in Simon is not a template image..."

The examiner suggests to the applicant to explicitly define a template image so that a broadest reasonable interpretation can be applicable (see MPEP 2111). Note that Simon describes a template image in the context of a layout. The examiner believes that the template and layout are the same as taught in Simon. Would one of ordinary skill in the art come to the same conclusion without an explicit definition of a template image?

33.   In response to applicant's argument on page 32, line 20 that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "...composite image...") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

34.   Applicant's arguments on page 34 have been fully considered but they are not persuasive and states:

"...Anderson does not teach the 'constructing' feature..."

The examiner respectfully disagrees since Anderson does teach the constructing

feature in fig. 3,num. 310 where a program analyzes a scanned image as shown in fig.

2 to prompt a user to scan an image to be placed in fig. 2,num. 204 based on the

analysis.

35.   In response to applicant's argument on page 34, lines 12,13 that the references

fail to show certain features of applicant's invention, it is noted that the features upon

which applicant relies (i.e., "...scanned image...") are not recited in the rejected

claim(s). Although the claims are interpreted in light of the specification, limitations from

the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26

USPQ2d 1057 (Fed. Cir. 1993).

36.   Applicant's arguments on page 34 have been fully considered but they are not

persuasive and states:

"...Anderson fails to disclose... 'for each placement region of the one or

more placement regions, placing a digital image from the first set of digital

images identified for the placement region in the placement region on the

first digital image to generate the customized digital image'..."

The examiner respectfully disagree since Anderson discloses for each placement region of the one or more placement regions (as shown in fig. 2,num. 204), placing (based on a "position" in col. 4, line 13) a digital image (one image from "both images" in col. 5, line 61) from the first set of digital images (said both images) identified (by a user since a "desired image [by a user]" in col. 5, line 61 is being used) for the placement region in the placement region on the first digital image to generate the customized digital image.

37.   In response to applicant's argument on page 34, lines 19,20 that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "...one or more placement regions on a template image...") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

38.   In response to applicant's argument on page 34, line 23 that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "...composite image...") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Claim Rejections - 35 USC § 102

39.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

40.   Claim 18 is rejected under 35 U.S.C. 102(e) as being anticipated by Takahashi

(US Patent 6,867,882 B1).

Regarding claim 18, Takahashi discloses a method of generating a customized

digital image the method comprising:

a)   receiving (via "print layout memory" in col. 12, line 34 that stores which is

interpreted as receiving) a first digital image (fig. 15,num. 203) using an image capture

device (fig. 12,num. 101) having a selectable mode (fig. 5, num. S11) for capturing (via

"print layout memory" in col. 12, line 34 is interpreted as capturing since the memory

stores which is also interpreted to mean capturing) a template image (as shown in fig.

16);

b)   <u>constructing one or more placement regions from the first digital image</u>

<u>based upon features extracted from (see paragraphs 15-18 and 21 above)</u> the first

digital image by applying an image analysis technique to the first digital image (a user

decides where to move the images and enlarge or reduce images via a pointer as

shown in fig. 15,num. 1201) to determine a first placement region (fig. 16, label: IMAGE

2 was moved to a new location relative "IMAGE 2" of fig. 12) on the first digital image

(fig. 16,num. 203) for placing a second digital image; and

c)   placing the second digital image (as shown in fig. 15, label: IMAGE 2) in

the first placement region (as shown in fig. 2, label: IMAGE 2) on the first digital image

(fig. 16,num. 203 is the same image as fig. 15,num. 203) to generate the customized

digital image (as shown in fig. 20).

41.   Claims 18,24,25 and 26 are rejected under 35 U.S.C. 102(e) as being anticipated

by Yamazaki (US Patent 6,999,117 B2).

Regarding claim 18, Yamazaki discloses a method of generating a customized

digital image the method comprising:

a)   receiving a first digital image (as shown in fig. 6B) using an image capture

device (fig. 1A,num. 10) having a selectable mode (the output of fig. 3A,num. 100:

INFORMATION INPUT MODE) for capturing a template image (as shown in fig. 7A);

b)   constructing one or more placement regions (as shown in fig. 7A: IMAGE)

from the first digital image based upon features extracted (as done in fig. 4, num. 170)

from the first digital image by applying an image analysis technique (as done in fig.

4,num. 172) to the first digital image to determine a first placement region on the first

digital image for placing a second digital image; and

c)   placing (as indicated in fig. 7A: POSITION FOR SYNTHESIS OF

DESIGNATED IMAGE) the second digital image in the first placement region on the first

digital image to generate the customized digital image (as shown in fig. 7A).

Regarding claim 24, Yamazaki discloses a method of generating a customized

digital image using a digital camera, the method comprising:

a)   capturing one or more images using the digital camera with the digital

camera in a first mode (fig, 9A: PHOTOGRAPH MODE);

b)   capturing a template image (fig. 7A) by imaging a paper medium (or

"sheet of paper" in col. 38, lines 11,12) with the digital camera in a second mode (fig.

9A: INFORMATION INPUT MODE);

c)   determining in the digital camera one or more placement regions (a shown in fig. 7A as IMAGE) from the template image, each placement region of the one or more placement regions identifying a location on the template image for placing an image from the one or more images captured using the digital camera;

d)   identifying in the digital camera, for each placement region of the one or more placement regions, an image (fig. 12D) from the one or more images (fig. 12C) to be placed in the placement region; and

e)   for each placement region of the one or more placement regions, placing a copy (as shown in the right side of fig. 12G that is a cropped version of the image of fig. 12D) of an image from the one or more images identified for the placement region in the placement region to generate the customized digital image (fig. 12G).

Claim 25 is rejected the same as claim 24. Thus, argument similar to that presented above for claim 24 is equally applicable to claim 25.

Regarding claim 26, Yamazaki discloses the method of claim 25 wherein using

the digital camera to capture a template image <u>further</u> comprises:

a)   imprinting the one or more bounded regions on a paper medium (as

shown in fig. 7B that has bounded regions on a sheet of paper); and

b)   using the digital camera to capture the one or more images (in

PHOTOGRAPH MODE in fig. 9A) comprises:

b1)   capturing the one or more images using the digital camera without

selecting the button of the digital camera (see fig. 9A: since a

PHOTOGRAPH MODE was selected instead of INFORMATION

INPUT MODE or IMAGE PLAYBACK MODE).

42.   Claims 17,45 and 71 are rejected under 35 U.S.C. 102(e) as being anticipated by

Simon et al. (US Patent Application Publication No.: US 2002/0040375 A1 or serial

number 09/825,453).

Regarding claim 17 Simon et al. discloses a method of generating a customized

digital image, the method comprising:

a)   receiving a signal (via the input of fig. 5,num. 110) comprising:

a1)   digitals signals representative of a plurality of digital images (as

shown in fig. 5,num. 100), the plurality of digital images captured using an image

capture device (fig. 1, num. 20 is interpreted as a capture device since num. 20 stores

the images where the action of storing is interpreted to also mean capturing);

b)   determining a template image (fig. 5,num. 160) from the plurality of digital

images (fig. 5,num. 100) based upon a selection entered (at fig. 1,num. 110) via the

image capture device (fig. 1, num. 20);

c)   constructing (see paragraphs 26 and 28 above) one or more placement

regions (fig. 17,num. 286) from the template image based upon features extracted from

the template image (see paragraph 28 above) by applying an image analysis technique

(via the method of fig. 7) to the template image, each placement region of the one or

more placement regions identifying a location on the template image for receiving a

digital image (as shown in fig. 15,num. 60) from the plurality of digital images captured

by the image capture device;

d)   identifying, for each placement region of the one or more placement

regions, a digital image from the plurality of digital images to be placed in the placement

region (as shown in fig. 15,num. 60); and

e)   for each placement region of the one or more placement regions, placing

a copy (Fig. 13,num. 62 is a copy relative to fig. 11,num. 62)) of a digital image from the

plurality of digital images identified for the placement region in the placement region on

the template image (see paragraph 30 above) to generate the customized digital image

(as shown in fig. 13).

Claim 45 is rejected the same as claim 17. Thus, argument similar to that

presented above for claim 17 is equally applicable to claim 45 except for the limitation

of:

a)   a processor (fig. 8,num. 802); and

b)   a memory (fig. 8,num. 804) coupled to the processor.

Claim 71 is rejected the same as claim 17. Thus, argument similar to that

presented above for claim 17 is equally applicable to claim 71 except for the additional

limitation disclosed in Simon et al. of a computer program product (fig. 1,num. 20).

43.   Claims 1,3-5,7-16,19-22,27,29-31,33-44,46-50,52,54-60,62-70 and 72-76 are

rejected under 35 U.S.C. 102(e) as being anticipated by Shaffer et al. (US Patent

6,396,963 B2).

Regarding claim 1, Shaffer et al. discloses a method of generating a customized

digital image, the method comprising:

a)   receiving a first digital image (via the inputs of fig. 7, num. 152)

from an image capture device (or scanner of fig. 7,num. 157), the first digital

image designated as a template image using the capture device (see paragraph

3 above) having a selector for identifying the first digital image as a template

image (fig. 9,num. 164 is interpreted as a selector for identifying. Since the

scanner of fig. 7,num. 157 scans the sheet of fig. 9,num. 160 the scanner is

inputting or having a selector or identifier as shown in fig. 9,num. 164 that is used

to identify the first digital image as shown in fig. 9,num. 160 after scanning. Note

that the claimed selector is interpreted to perform the action of identifying and not

selecting.);

b)   constructing (see paragraphs 4-7 above) one or more placement

regions (fig. 9 shows at the top left one placement region or the smaller rectangle

enclosed by a larger rectangle) from the first digital image (top left larger

rectangle) based upon features extracted from the first digital image (see

paragraphs 6 and 7 above) by applying an image analysis technique ("pattern

recognition" in col. 13, line 13) to the first digital image, each placement region of

the one or more placement regions identifying a location on the first digital image

for placing a digital image from a first set of digital images (one image from fig. 7,

num. 45) captured using the image capture device;

c)   identifying (via fig. 7,num. 149), for each placement region of the

one or more placement regions, a digital image from the first set of digital images

to be placed in the placement region; and

d)   for each placement region of the one or more placement regions,

placing a digital image (via fig. 6, label: "If new template, place proper picture into

template." Note that fig. 6 is a digital version; thus all processing of figure 6 is

digital.) from the first set of digital images identified (via fig. 7, num. 149) for the

placement region (or layout of fig. 7,num. 157) in the placement region on the

first digital image (see paragraph 8 above) to generate the customized digital

image (the output of fig. 7,num. 157.).

Regarding claim 3, Shaffer et al. discloses the method of claim 1 further

comprising:

a)   creating a link (or "list of images" in col. 13, line 22) between the

customized digital image and at least one digital image ("high resolution image"

in col. 13, line 23) from a second set of digital images (or "image storage" in col.

13, line 24), wherein the link enables access to the at least one digital image

from the second set of digital images using the customized digital image (or

"scanned layout sheets" in col. 13, line 26).

Claim 4 is rejected the same as claim 3. Thus, argument similar to that

presented above for claim 3 is equally applicable to claim 4 except for requiring the

limitation of a user as disclosed in Shaffer et al. via a "Customer" in fig. 7,num. 14.

Regarding claim 5, Shaffer et al. discloses the method of claim 1 wherein

receiving the first digital image comprises:

a)   scanning a paper medium on which the one or more placement region

have been indicated to generate the first digital image (via the last step of fig. 5 (Analog

version)).

Regarding claim 7, Shaffer et al. discloses the method of claim 1 wherein the one

or more placement regions on the first digital image are indicated by one or more

bounded regions (as shown by the smaller rectangles of fig. 9).

Regarding claim 8, Shaffer et al. discloses the method of claim 1 wherein the one

or more placement regions on the first digital image are indicated by one or more text

fragments (fig. 8, num. 119 or fig. 9.num. 164).

Claim 9 is rejected the same as claim 8. Thus, argument similar to that

presented above for claim 8 is equally applicable to claim 9.

Regarding claim 10, Shaffer et al. teaches the method of claim 1 wherein identifying, for each placement region of the one or more placement regions, a digital image from the first set of digital images to be placed in the placement region comprises:

a)   determining image identification information (via "pattern recognition" in col. 13, line 13) associated with at least a first placement region of the one or more placement regions from the first digital image, the image identification information identifying an attribute ("embedded...data" in col. 12, lines 63,64) of a digital image to be placed in the at least first placement region;

b)   identifying a first digital image from the first set of digital images to be placed in the at least first placement region based upon the image identification information (or "image identification" in col. 13, line 21) associated with the at least first placement region (via "image stickers" in col. 12, lines 61,62 that was placed in any one rectangle of fig. 9.).

Claim 11 is rejected the same as claim 10. Thus, argument similar to that presented above for claim 10 is equally applicable to claim 11.

Claim 12 is rejected the same as claim 10. Thus, argument similar to that presented above for claim 10 is equally applicable to claim 12 except for the additional limitation of a time stamp which is disclosed in Shaffer et al. in col. 11, line 66: "data and time" or "image identification" in col. 12, line 18 which is used for embedding into an image in col. 12, line 18-21.

Regarding claim 13, Shaffer et al. discloses the method of claim 1 wherein placing a digital image from the first set of digital images identified for the placement region in the placement region to generate the customized digital image comprises:

a) adjusting (or "zoom and crop" in col. 13, line 32) the digital image to fit the placement region.

Claim 14,15 and 16 are rejected the same as claim 13. Thus, argument similar to that presented above for claim 13 is equally applicable to claims 14,15 and 16.

Claims 19 and 20 are rejected the same as claim 3. Thus, argument similar to that presented above for claim 3 is equally applicable to claims 19 and 20.

Claims 21 and 22 are rejected the same as claims 4 and 5. Thus, argument similar to that presented above for claims 4 and 5 is equally applicable to claims 21 and 22.

Claim 27 are rejected the same as claim 1. Thus, argument similar to that presented above for claim 1 is equally applicable to claim 27 except for the additional limitation disclosed in Shaffer et al.:

a) an input module (the inputs of fig. 7,num. 152);

b) a processing module (fig. 7,num. 152);

c) wherein the input module is configured to receive a first digital image captured with an image capture device (via a scanner of fig. 7,num. 157); and

d) wherein the processing module is configured to perform the method of claim 1, addressed above.

Claims 29-31 and 33-42 are rejected the same as claims 3-5 and 7-16, respectively. Thus, argument similar to that presented above for claims 3-5 and 7-16 is equally applicable to claims 29-31 and 33-42, respectively.

Regarding claim 43, Shaffer at al. discloses a digital camera ("digital camera" in col. 13, line 37) that incorporates the system of claim 27.

Regarding clam 44, Shaffer et al. discloses a copying machine (or scanner of fig. 7,num. 157) that incorporates the system of claim 27.

Claim 46 is rejected the same as claim 1. Thus, argument similar to that presented above for claim 1 is equally applicable to claim 46 except for the additional limitation disclosed in Shaffer et al.:

a)   a processor (fig. 4,num. 94); and

b)   a memory (fig. 4,num. 102) for storing a program;

c)   wherein the processor is operative with the program to:

c1)   receive a first digital image; and

c2)   receive a second digital image (via fig. 4,num. 104).

Claims 47-50 are rejected the same as claims 19-22. Thus, argument similar to that presented above for claims 19-22 is equally applicable to claims 47-50.

Claims 52 and 54 are rejected the same as claim 46. Thus, argument similar to that presented above for claim 46 is equally applicable to claims 52 and 54.

Claims 55 and 56 are rejected the same as claims 43 and 44. Thus, argument similar to that presented above for claims 43 and 44 is equally applicable to claims 55 and 56.

Claim 57 is rejected the same as claim 1. Thus, argument similar to that presented above for claim 1 is equally applicable to claim 57 except for the additional limitation as disclosed in Shaffer et al. of a computer program product (fig. 4,num. 102).

Claims 58-60 and 62-67 are rejected the same as claims 3-5 and 7-12, respectively. Thus, argument similar to that presented above for claims 3-5 and 7-12 is equally applicable to claims 58-60 and 62-67, respectively.

Claim 68 is rejected the same as claims 13 and 16. Thus, argument similar to that presented above for claims 13 and 16 is equally applicable to claim 68.

Claims 69 and 70 are rejected the same as claims 14 and 15. Thus, argument similar to that presented above for claims 14 and 15 is equally applicable to claims 69 and 70.

Claim 72 is rejected the same as claim 57. Thus, argument similar to that presented above for claim 57 is equally applicable to claim 72.

Claims 73-76 are rejected the same as claims 19-22. Thus, argument similar to that presented above for claims 19-22 is equally applicable to claims 73-76.

Claim Rejections - 35 USC § 103

44.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

45.   Claims 6,23,32,51,61 and 77 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Shaffer et al. (US Patent 6,396,963 B2) in view of Anderson (US

Patent 6,690,396 B1).

Regarding claim 6, Shaffer et al. does not teach photographing a paper medium

to generate the claimed first digital image, but does teach two methods (figures 5 and 6)

of generating the claimed first digital image. Thus, Shaffer e al. suggests that there is a

plurality of methods that can be used to generate the claimed first digital image.

Anderson et al. teaches another method of creating the claimed first digital image

as shown in figure 2 and the additional limitation of:

a)   photographing (via a "CCD...[or]...capture device" in col. 9, lines 65-67) a

paper medium (or "TANGIBLE MEDIUM" of fig. 1,num. 102) on which the one or more

placement regions have been indicated (as shown in fig. 2,num. 204) to generate the

first digital image (fig. 2,num. 202).

It would have been obvious at the time the invention was made to one of ordinary

skill in the art to modify Shaffer et al.'s two methods of figure 5 and 6 to generate the

claimed first digital image with Anderson et al.'s teaching of using a CCD or capture

device, because Anderson et al.'s teaching does not limit the types of devices and

provides a plurality of devices for generating the claimed first digital image.

Claims 23,32,51,61 and 77 are rejected the same as claim 6. Thus, argument

similar to that presented above for claim 6 is equally applicable to claims 23,32,51,61

and 77.

46.   Claims 18-23 is rejected under 35 U.S.C. 103(a) as being unpatentable over

Anderson (US Patent 6,690,396 B1) in view of Takahashi (US Patent 6,867,882 B1).

Regarding claim 18, Anderson teaches a method of generating a customized

digital image, the method comprising:

a)   receiving a first digital image (via the input of fig. 1,num. 106 as shown in

fig. 2 via output arrow of fig. 1,num. 104) using an image capture device (fig. 8,num.

818) having a selectable mode for capturing a template image;

b)   <u>constructing one or more placement regions from the first digital image</u>

<u>based upon features extracted from (see paragraph 34 above)</u> the first digital image

(Fig. 1, num. 106) by applying an image analysis technique (or "correlation" in col. 3,

line 46 that identifies features, fig. 2, numerals 204-216.) to the first digital image to

determine a first placement region (fig. 2,num. 204) on the first digital image for placing

a second digital image ("3 X 5 PHOTOGRAPH" in fig. 2,num. 204 after scanning.);

c)   placing the second digital image in the first placement region on the first

digital image (fig. 3, num. 312 via a format operation) to generate the customized digital

image (as shown in fig. 4,num. 402 and see paragraph 36 above).

Anderson does not teach the claimed having a selectable mode for capturing a

template image. However, Anderson does suggest that a plurality of capture devices

can be used as shown in fig. 8,numerals 818,820 and 822.

Takahashi teaches one such image capture device as shown in fig. 21,num. 101

that can be used with Anderson's fig. 8, numerals 818,820 and 822 and the remaining

limitation of:

a)   an image capture device (fig. 21,num. 101) having a selectable mode (fig. 24, num. S81) for capturing a template image (as done in fig. 26,num. S105 that stores a "PRINT IMAGE" shown and described in fig. 26,num. S105 that includes a "TEMPLATE IMAGE" shown and described in fig. 26,num. S105).

It would have been obvious at the time the invention was made to one of ordinary skill in the art to modify Anderson's teaching of using a plurality of image capture devices with Takahashi's image capture device that enables "image process operations [that] become easy and convenient for the user" in col. 15, lines 59,60.

Regarding claim 19, Anderson discloses the method of claim 18 wherein the second digital image is a copy (or "thumbnail" in col. 5, line 58) of a third digital image (or "expanded view" in col. 5, line 58).

Claims 20 and 21 are rejected the same as claim 19. Thus, argument similar to that presented above for claim 19 is equally applicable to claims 20 and 21.

Regarding claim 22 see figure 1, numerals 102 and 104.

Regarding claim 23, Anderson discloses a "CCD" in col. 9, line 65.

47.   Claim 53 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shaffer

et al. (US Patent 6,396,963 B2) in view of Takahashi (US Patent 6,867,882 B1).

Regarding claim 53, Shaffer et al. does not teach the limitations of claim 53 with

respect to said digital camera; however, Shaffer et al. suggests to one of ordinary skill in

the art that a plurality of image capture devices can be used as shown in fig. 2,

numerals 8,12,10 and 6.

Takahashi teaches one such image capture device as shown in fig. 13,num. 101

and the remaining limitations of claim 53 of:

a)   a first button (fig. 13,num. 206) which when selected indicates (via a

screen as shown in fig 13,num. 203) that an image received by the digital camera is a

template image (as shown in fig. 15).

It would have been obvious at the time the invention was made to one of ordinary

skill in the art to modify Shaffer et al.'s teaching of using a plurality of image capture

devices with Takahashi's image capture device that enables "image process operations

[that] become easy and convenient for the user" in col. 15, lines 59,60.

Conclusion

48.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dennis Rosario whose telephone number is (571) 272-7397. The examiner can normally be reached on 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew Bella can be reached on (571) 272-7778. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Dennis Rosario
Unit 2624

MATTHEW C. BELLA
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600